

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MOTOYOSHI KOMODA

Appeal No. 1998-0493
Application 08/364,000

ON BRIEF

Before JERRY SMITH, BARRETT, and HECKER, Administrative Patent Judges.

HECKER, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 6, all claims pending in this

application. The invention relates to a cellular telephone feature which reduces unused channel time. In particular, when the battery voltage drops below an operable level, it takes several seconds for the base station to recognize that the cellular unit has stopped communication. The invention minimizes these wasted seconds by informing the user and initiating a timer count when the battery voltage falls below a certain level. After the timer has reached a certain count, and the battery voltage is still low, the unit forcibly terminates communication after notifying the user. When terminating, the unit executes a conversation ending procedure, signaling the base station that it may release the channel. This conversation ending procedure saves the base station several seconds in realizing the unit has stopped communication.

Representative independent claim 1 is reproduced as follows:

1. A radio telephone apparatus comprising:
a power source;
a voltage measuring means for measuring an output

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voltage of said power source;

decision means for determining whether the voltage measured by said voltage measuring means is lower than a predetermined voltage;

a radio section for transmitting signals to and receiving signals from a fixed telephone network and other radio telephone apparatuses, via a base station, connected to said radio telephone apparatuses, occupying a channel of communication;

control means for controlling said radio section, said control means comprising time counting means started in response to an output of said decision means for counting a predetermined period of time, and conversation ending means responsive to an output of said time counting means for executing a conversation ending procedure when a conversation is under way, to signal said base station to release said channel of communication.

The Examiner relies on the following references:

Sato et al.	4,933,963	Jun. 12, 1990 (filed Nov. 23, 1988)
Hewitt	5,095,308	Mar. 10, 1992 (filed Jan. 9, 1990)
Saito	EP 0 280 501	Aug. 31, 1988

Kerr, Cellular Telephone Technology and Practice, George Washington University CEEP course, 1986, 1994, page 4-16.¹

¹Kerr and Lee did not appear in the final rejection. The Examiner has introduced them for the sole purpose of

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Lee, Mobile Cellular Telecommunications Systems, McGraw-Hill Book Company, pages 77, 84 and 85.²

Claim 1 stands rejected under 35 U.S.C. § 103 as being unpatentable over Saito in view of Kerr or Lee.

Claim 2 stands rejected under 35 U.S.C. § 103 as being unpatentable over Saito in view of Kerr or Lee and further in view of Hewitt.

Claims 3 through 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Saito in view of Kerr or Lee and further in view of Hewitt and Sato.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the brief, reply brief and answer for the respective details thereof.

OPINION

substantiating the "Official Notice" portion of the final rejection. Appellant has considered them in the reply brief.

² Although no publication date appears, Appellant has not contested its use as prior art.

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After a careful review of the evidence before us, we will not sustain the rejection of claims 1 through 6 under 35 U.S.C. § 103.

At the outset, we note that Appellant has indicated on page 4 of the brief all claims stand or fall together with claim 1.

The Examiner has failed to set forth a ***prima facie*** case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the reasonable teachings or suggestions found in the prior art, or by a reasonable inference to the artisan contained in such teachings or suggestions. ***In re Sernaker***, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." ***Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.***, 73 F.3d 1085, 1087, 37 USPQ2d 1237,

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1239 (Fed. Cir. 1995) (*citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)).

With regard to the rejection of claim 1, the Examiner takes the position that Saito teaches all the limitations of the claim except signaling the base station to release the channel. The Examiner then takes Official Notice that it is well known to signal the base station to release the channel, and evidences this notice via Kerr and Lee. The Examiner indicates

that it would have been obvious to one of ordinary skill in the art to combine the well known channel release with Saito. (Answer-pages 3 and 4.)

Appellant does not contest that Saito teaches the basic radio telephone limitations recited in claim 1. Appellant even acknowledges that Saito provides for conversation ending. However, Appellant argues that Saito's conversation ending places the unit in a waiting state until such time that operating voltage is restored, and then resumes

communication. (Brief-pages 5 and 6.) Appellant states "Thus, the channel is maintained, presumably in the hope that operating voltage level would be restored and communication resumed. This is contrary to the claimed invention wherein the base station is signalled to drop the channel, and communication is forcibly terminated." (Brief-pages 6 and 7.)

We acknowledge the Examiner's evidence, and we believe Appellant agrees, that it is well known to terminate a conversation and signal the base station to drop the channel (evidenced by Kerr and Lee). However, we agree with Appellant. Although Saito terminates conversation upon detection of a low voltage, it then goes into a "waiting state". There is nothing in the record to indicate Saito's "waiting state" is the same as terminating a conversation and relinquishing the channel. Saito's "waiting state" appears to be a non relinquishing of the channel. This is indicated by Saito wherein it states:

Unless the normal voltage level is restored even after the lapse of three seconds from the voltage drop, the mobile radiotelephone **stays in an inoperable state**. (Emphasis added.)(Column 1, lines 23-26.)

Even if it were obvious to combine Kerr or Lee with Saito to perform a **conventional** conversation ending procedure, wherein the base station is signaled to release the channel, we find no teaching or suggestion to apply this procedure to Saito's "waiting state". As argued by Appellant (brief-page 4), such a conclusion could only come from impermissible hindsight.

The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." ***In re Fritch***, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), ***citing In re Gordon***, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." ***Para-Ordinance Mfg. v. SGS Importers Int'l***, 73 F.3d at 1087, 37 USPQ2d at 1239, ***citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.***, 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13.

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As pointed out above, Appellant uses a conventional conversation ending procedure (e.g., Kerr or Lee) to signal a base station for a **release of channel when battery voltage becomes low**. Saito ends conversation **when battery voltage becomes low**, but goes into a "**waiting state**". We are unconvinced that Saito's "waiting state" is meant to release the channel. Thus we find no motivation to combine Kerr or Lee with Saito for use when battery voltage becomes low. Accordingly, we will not sustain the Examiner's rejection of claim 1, and likewise claims 2 through 6 which depend from claim 1 and include the same unmet limitations.

We have not sustained the rejection of claims 1 through 6 under 35 U.S.C. § 103. Accordingly, the Examiner's

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decision is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
LEE E. BARRETT))
Administrative Patent Judge)	APPEALS AND
)	
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STUART N. HECKER)	
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